

REMARKS:

The drawings were objected to for a duplicative reference numeral and failing to include a reference numeral.

The Specification was objected to for lack of page numbers.

Claims 1-42 are currently pending in the Application.

Claims 1-42 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which Applicant regards as the invention.

Claims 1 and 30 were rejected under 35 U.S.C. §102(b) as being anticipated by Whitney, U.S. Pat. No. 156,614.

Claims 1-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lindsey, U.S. Pat. No. 6,260,748 in view of *Howard v. Detroit Steel Works* 150 U.S. 164 (1893) and *In Re Boesch*, 617 F.2d 272

No claims were allowed.

REGARDING EXAMINER'S DRAWING OBJECTIONS:

Applicant has amended the specification to reference sign 61, as depicted in the drawings. Likewise applicant has corrected references of the stock in the specification to all read "59" as is labeled in FIG. 5, not "52". As such, Examiner's objections to the drawings should now be corrected and no amended drawings should be required.

REGARDING EXAMINER'S SPECIFICATION OBJECTIONS:

Applicant points out that the software issued by the PTO at that time for electronic filing does not seem to place page numbers on the sheets, but rather numbered the paragraphs. Applicant

is willing to file a substitute specification in the entirety, including claims and abstract, under 37 CFR 1.125(a) (See MPEP 608.01(u)) should Examiner require it (which seems to be required before Applicant can submit a substitute specification in its entirety).

REGARDING EXAMINER'S §112 REJECTIONS BASED ON ENABLEMENT:

Applicant has amended the claims for the presently claimed invention to particularly point out and distinctly claim the subject matter of the invention in order to comply with the provisions of 35 U.S.C §112. Particularly, Applicant has amended the claims to eliminate functional language and references to "obverse" and "reverse" sides, and revised the language of the Markush claims to be more specific.

REGARDING EXAMINER'S §102 REJECTIONS BASED ON WHITNEY ('614):

Applicant has examined the prior art submitted with Examiner's Office Action and, after careful consideration, has amended the claims to clearly distinguish the claimed invention over the prior art.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). The identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.*, 9USPQ2d 1913, 1920 (Fed Cir. 1989).

In the process of clarification to overcome Examiner's §112 rejections, Applicant has amended claim 1 to make clear that the projection extends perpendicularly from the plane of the first planar side, which is not disclosed in Whitney, where the projection is a planar extension. As such, the amended claim should now overcome Examiner's §102 rejection.

REGARDING EXAMINER'S §103 REJECTIONS BASED ON LINDSAY ('748):

Applicant submits that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

After examining *Howard v. Detroit Steel Work*, 150 U.S. 164 (1893), Applicant noticed that the factual basis for the decision is entirely distinguishable from the instant Application. In *Howard*, the Appellant sought to overturn a lower court ruling invalidating claims in three separate patents. The specific argument regarding joining two pieces begins with discussion of the third patent, particularly comparing the patented grate with another grate termed "Monumental". *Id.* at 169. The Monumental grate had all of the elements of the Beckworth grate (the grate at issue), except that it was in two pieces instead of one, as was the Beckworth grate. *Id.* at 170. The Court concludes that casting the two pieces that made one grate together into one unitary grate did not require invention.

The *Howard* case differs from the instant application in that the two pieces referred to in *Howard* were two pieces that worked in conjunction with each other. Their very positioning and use suggested joining them, especially when they did not have to be in two separate pieces. *See, Id.* Therefore, in the *Howard* case, the *prima facie* case for obviousness is met because the prior art:

1. provided motivation (a two piece grate was unnecessary for a wood burning stoves);
2. taught the claim limitations (two pieces functioning as a whole grate);

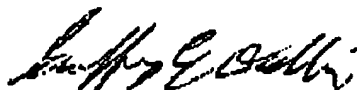
3. suggested using one composite piece as opposed to two (if the only reason for a two-piece grate is to open it, why use two when one will do); and
4. suggested the success of the fusion.

The current Application is not such a case, however. The two pieces in the Lindsay patent suggested by Examiner are not two pieces working or even found together when in use. They are used in the alternative, never together. As such, there is no suggestion to join them, as was found in the *Howard* case, much less any suggestion in the prior art to suggest combining two types of sling apertures on a unitary structure like the present invention (the Whitney patent discloses a secondary hook for joining weapons together, not a sling aperture) much less a plurality of pairs of such apertures. As such, Applicant respectfully suggests that Examiner's reliance on Lindsay alone with *Howard*, is an inappropriate rejection as the fusion is not suggested in the prior art, much less the configuration of apertures afterward.

Applicant submits that Claims 1-42 are now clearly allowable over the prior art and Applicant respectfully requests allowance of these Claims and the case passed for issue. If Examiner believes that a telephonic conference would facilitate the examination of this Application, or would resolve questions Examiner may have, please do not hesitate to call Applicant's Attorney at the contact information below.

Respectfully Submitted,

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